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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,086	08/26/2003	James F. Bredt	ZCO-107CP2	5896

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EXAMINER	
SHOSHO, CALLIE E	
ART UNIT	**PAPER NUMBER**
1714	

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/650,086	BREDT ET AL.	
	Examiner	Art Unit	
	Callie E. Shosho	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 October 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6,7,9-24,26-41,43-55,57-68,70-74 and 76-78* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6,7,9-24,26-41,43-55,57-68,70-74 and 76-78* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. All outstanding rejections are overcome by applicants' after-final amendment filed 10/5/06 that has been entered. It is noted that the double patenting rejection of record is overcome by applicants' filing of proper terminal disclaimer on 10/5/06.

In light of the new grounds of rejection set forth below, the finality of the previous office action has been withdrawn and thus, the following action is non-final.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-4, 6-7, 9-24, 26-41, 43-55, 57-68, 70-74, and 76-78 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Dry three dimension printing composition critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

As set forth on page 5, line 30-page 6, line 1 of the present specification, the three dimensional printing composition functions by reacting with aqueous fluid wherein the plaster contained in the particulate material of the three dimension composition is hydrated to form an essentially solid material. Further, page 12, line 21-page 13, line 30 of the present specification discloses the three dimension composition is utilized by placing layer of particulate material on substrate, delivering aqueous fluid causing the plaster present in the particulate material to

rehydrate, allowing the layer to solidify and then repeating the process. Thus, it appears that the three dimensional printing composition must contain no water, i.e. composition is dry. However, there is no such requirement in the present claims which, in light of the transitional language utilized, i.e. "comprising" or "including", are in fact open to the inclusion of additional ingredients including water.

4. Claims 31-32 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Plaster critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Present claims 31 and 32 each require three dimensional printing composition comprising about 10 to about 50% adhesive material, 0 to about 20% of a first fibrous component, and 0 to about 80% filler. However, as set forth on page 5, line 30-page 6, line 1 of the present specification, the three dimensional printing composition functions by reacting with aqueous fluid wherein the plaster contained in the particulate material of the composition is hydrated to form an essentially solid material. Thus, it appears that the three dimensional printing composition cannot function without the presence of plaster and that the presence of plaster is required. However, there is no disclosure of plaster in claims 31 and 32.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6 and 77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) The scope of claim 6 is confusing given that claim 6 depends on a cancelled claim. Should the dependency of claim 6 be changed from claim 5 to claim 1?

(b) Claim 77 contains the trademark/trade name Lodyne. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe oil and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4, 6-7, 9-13, 22-24, 26-30, 32, 34, 37, 50-54, 59-65, and 78 are rejected under 35 U.S.C. 102(b) as being anticipated by Elden (U.S. 3,303,147) taken in view of the evidence given in Slovinsky et al. (U.S. 5,385,772).

Elden discloses dry powder composition comprising plaster, adhesive, i.e. polyvinyl acetate powder and polyvinyl alcohol powder wherein the polyvinyl alcohol is at least 85% hydrolyzed, filler such as bentonite or limestone, retarding agent, accelerator, and carbohydrate, i.e. hydroxyethyl cellulose, methyl cellulose, gum arabic (acacia gum). It is disclosed that the plaster and filler have particle size of minus 100 mesh. Attention is called to claim 1 which discloses that the composition comprises about 40-65% plaster, about 4-10% adhesive, and about 23-54% filler and to claim 5 which discloses dry powder composition which, it is calculated, comprises approximately 20-70% plaster, 1.9-7.5% polyvinyl acetate, 0.3-2.3% polyvinyl alcohol, 0.13-0.23% retarding agent, and 0.2-0.4% accelerator (col.1, lines 10-13, col.1, line 50-col.2, line 47, col.2, lines 68-69, and col.4, lines 44-55). It is disclosed that the polyvinyl acetate powder utilized is known under the tradename VINAC RP 251 which is well known, as evidenced by Slovinsky et al. (col.2, lines 30-31, col.3, lines 9-19, and col.14, lines 28-30), to possess average particle size of 1-300 μm.

While there is no disclosure in Elden that the composition is a "three dimensional printing" composition or is "suitable for use in three dimensional printing to form an article comprised of a plurality of layers" as presently claimed, the recitation in the claims that the composition is "suitable for use in three dimensional printing to form an article comprised of a plurality of layers" is merely an intended use. Further, applicants attention is drawn to MPEP 2111.02 which states that "if the body of a claim fully and intrinsically sets forth all the

limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art composition and further that the prior art composition which is identical to that set forth in the present claims is capable of performing the recited purpose or intended use.

In light of the above, it is clear that Elden anticipates the present claims.

9. Claims 1-4, 7, 9-14, 16-23, 26-30, 32-35, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 2,155,944.

GB 2,155,944 disclose powder composition comprising 1-50% binder that is water-soluble polymer such as cellulose, i.e. hydroxypropyl cellulose, starch, synthetic polymer such as polyacrylic acid or polyvinyl alcohol, natural polymer such as locust bean gum, protein, i.e. gelatin, or polysaccharide such as xanthan gum or dextrin, 30-80% filler including gypsum,

silica, and calcium carbonate, and 0-10% polymer such as polyvinyl acetate (page 1, lines 6 and 14-46 and col.2, lines 14-28).

While there is no disclosure in GB 2,155,944 that the composition is a "three dimensional printing" composition or is "suitable for use in three dimensional printing to form an article comprised of a plurality of layers" as presently claimed, the recitation in the claims that the composition is "suitable for use in three dimensional printing to form an article comprised of a plurality of layers" is merely an intended use. Further, applicants attention is drawn to MPEP 2111.02 which states that "if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art composition and further that the prior art composition which is identical to that set forth in the present claims is capable of performing the recited purpose or intended use.

In light of the above, it is clear that GB 2,155,944 anticipates the present claims.

Claim Rejections - 35 USC § 103

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 14, 18-19, 21, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elden (U.S. 3,303,147) in view of Maynard et al. (U.S. 3,297,601).

The disclosure with respect to Elden in paragraph 8 above is incorporated here by reference.

The difference between Elden and the present claimed invention is the requirement in the claims of starch, organic acid, and specific retarding agent.

Maynard et al., which is drawn to dry powder composition comprising plaster, disclose the use of starch in order to ensure the formation of good bond in the composition especially under low temperature and low humidity drying conditions. Maynard et al. also disclose the use of citric acid as a retarding agent in order control the setting time of the composition with more uniform results (col.4, lines 38-43, 52-54, and 57-63 and col.5, lines 20-27).

In light of the motivation for using starch and citric acid disclosed by Maynard et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use starch and citric acid in Elden in order to produce composition with desired setting time that has good binding characteristics, and thereby arrive at the claimed invention.

12. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elden (U.S. 3,303,147) in view of Murray et al. (U.S. 4,042,408).

The disclosure with respect to Elden in paragraph 8 above is incorporated here by reference.

The difference between Elden and the present claimed invention is the requirement in the claim of sugar.

Murray et al., which is drawn to dry cement composition comprising gypsum, disclose the use of sucrose in order to produce desired setting characteristics and strength development (col.6, lines 51-57).

In light of the motivation for using sucrose disclosed by Murray et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use sucrose in Elden in order to produce composition with desired setting characteristics and strength development, and thereby arrive at the claimed invention.

13. Claims 16-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elden (U.S. 3,303,147) in view of GB 2,155,944.

The disclosure with respect to Elden in paragraph 8 above is incorporated here by reference.

The difference between Elden and the present claimed invention is the requirement in the claims of protein.

GB 2,155,944, which is drawn to dry powder composition comprising gypsum, disclose the use of protein, i.e. gelatin, as a binder (page 1, lines 17, 25-26, and 30). GB 2,155,944 also

discloses the equivalence and interchangeability of using protein binder with using polyvinyl alcohol binder as disclosed by Elden.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use protein as the binder in Elden, and thereby arrive at the claimed invention.

14. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elden (U.S. 3,303,147) in view of Desmarais (U.S. 3,835,074).

The disclosure with respect to Elden in paragraph 8 above is incorporated here by reference.

The difference between Elden and the present claimed invention is the requirement in the claim of fiber.

Desmarais, which is drawn to dry cement composition, disclose the use of cellulose fiber that is used in place of asbestos (as disclosed by Elden) and that imparts lubricity and workability to the composition (col.1, lines 35-67 and col.2, lines 53-61).

In light of the motivation for using cellulose fiber disclosed by Desmarais as described above, it therefore would have been obvious to one of ordinary skill in the art to use cellulose fiber in place of asbestos in Elden in order to produce a safer composition with good lubricity and workability, and thereby arrive at the claimed invention.

15. Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elden (U.S. 3,303,147) in view of Riddell (U.S. 2,662,024).

The disclosure with respect to Elden in paragraph 8 above is incorporated here by reference.

The difference between Elden and the present claimed invention is the requirement in the claim of dextrin.

Ridell et al., which is drawn to dry cement composition comprising gypsum, disclose the use of dextrin in order to produce composition with desired bulkiness (col.2, line 42-col.3, line 13).

In light of the motivation for using dextrin disclosed by Riddell et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use dextrin in Elden in order to produce composition with desired bulkiness, and thereby arrive at the claimed invention.

16. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elden (U.S. 3,303,147) in view of Riddell et al. (U.S. 2,662,024).

Elden discloses dry powder composition comprising plaster, adhesive, i.e. polyvinyl alcohol powder that is at least 85% hydrolyzed, and accelerator (col.1, lines 10-13, col.1, line 50-col.2, line 47, col.2, lines 68-69, and col.4, lines 44-55).

The difference between Elden and the present claimed invention is the requirement in the claims of dextrin.

Ridell et al., which is drawn to dry cement composition, disclose the use of dextrin in order to produce composition with desired bulkiness (col.2, line 42-col.3, line 13).

In light of the motivation for using dextrin disclosed by Riddell et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use dextrin in Elden in order to produce composition with desired bulkiness, and thereby arrive at the claimed invention.

17. Claims 39-41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elden (U.S. 3,303,147) in view of Carroll et al. (U.S. 3,309,328) and Slovinsky et al. (U.S. 5,385,772).

Elden discloses dry powder composition comprising plaster, adhesive, i.e. polyvinyl acetate powder and polyvinyl alcohol powder wherein the polyvinyl alcohol is at least 85% hydrolyzed, filler such as bentonite or limestone, retarding agent, accelerator, and carbohydrate, i.e. hydroxyethyl cellulose, methyl cellulose, gum arabic (acacia gum) (col.1, lines 10-13, col.1, line 50-col.2, line 47, col.2, lines 68-69, and col.4, lines 44-55). It is disclosed that the polyvinyl acetate powder utilized is known under the tradename VINAC RP 251 which is well known, as disclosed by Slovinsky et al. (col.2, lines 30-31, col.3, lines 9-19, and col.14, lines 28-30), to possess average particle size of 1-300 μm.

The difference between Elden and the present claimed invention is the requirement in the claims of printing aid, i.e. lecithin.

Carroll et al., which is drawn to adhesive composition, disclose the use of lecithin as a dispersing agent (col.4, lines 1-9).

In light of the motivation for using lecithin disclosed by Carroll et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use lecithin as dispersant in the composition of Elden, and thereby arrive at the claimed invention.

18. Claims 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elden in view of Carroll et al. as applied to claim 39-41 and 43 above, and further in view of Maynard et al. (U.S. 3,297,601).

The difference between Elden in view of Carroll et al. and the present claimed invention is the requirement in the claims of starch.

Maynard et al., which is drawn to dry powder composition comprising plaster, disclose the use of starch in order to ensure the formation of good bond in the composition especially under low temperature and low humidity drying conditions (col.4, lines 38-43, 52-54, and 57-63 and col.5, lines 20-27).

In light of the motivation for using starch disclosed by Maynard et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use starch in the composition of Elden in order to produce composition with desired setting time that has good binding characteristics, and thereby arrive at the claimed invention.

19. Claims 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elden in view of Carroll et al. as applied to claim 39-41 and 43 above, and further in view of Desmarais (U.S. 3,835,074).

The difference between Elden in view of Carroll et al. and the present claimed invention is the requirement in the claim of fiber.

Desmarais, which is drawn to dry cement composition, disclose the use of cellulose fiber that is used in place of asbestos (as disclosed by Elden) and that imparts lubricity and workability to the composition (col.1, lines 35-67 and col.2, lines 53-61).

In light of the motivation for using cellulose fiber disclosed by Desmarais as described above, it therefore would have been obvious to one of ordinary skill in the art to use cellulose fiber in place of asbestos in Elden in order to produce a safer composition with good lubricity and workability, and thereby arrive at the claimed invention.

20. Claims 72-74 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang (U.S. 3,852,083) in view of Maynard et al. (U.S. 3,297,601).

Yang disclose composition comprising plaster, filler such as kaolin, adhesive, i.e. polyvinyl alcohol, and mineral oil (col.1, lines 11-17, col.4, lines 36-40, col.8, lines 17-25, and col.9, lines 12-17 and 57).

The difference between Yang and the present claimed invention is the requirement in the claims of accelerator.

Maynard et al., which is drawn to dry powder composition comprising plaster, disclose the use of accelerator such as potassium sulfate in order to control the setting time of the composition (col. 4, lines 38-43 and 50-52).

In light of the motivation for using accelerator disclosed by Maynard et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such accelerator in Elden in order to produce composition with desired setting time, and thereby arrive at the claimed invention.

21. **NOTE:** With respect to the rejections set forth in paragraphs 16-20 above, it is noted that while there is no disclosure in Elden, Riddell et al., Carroll et al., Yang, or Maynard et al. that the composition is a "three dimensional printing" composition or is "suitable for use in three dimensional printing to form an article comprised of a plurality of layers" as presently claimed, the recitation in the claims that the composition is "suitable for use in three dimensional printing to form an article comprised of a plurality of layers" is merely an intended use. Further, applicants attention is drawn to MPEP 2111.02 which states that "if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art composition. Given that the combination of Elden with Ridell et al., Elden with Carroll et al. or Yang with Maynard et al. each disclose composition as presently claimed, it is

clear that each such composition would be capable of performing the recited purpose or intended use presently claimed as required in the above cited portion of the MPEP.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
10/18/06